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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/646,193	08/22/2003	Peter Bain	ALTRP087/A997	9066

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EXAMINER	
GEBRESILASSIE, KIBROM K	

ART UNIT	PAPER NUMBER
2128	

MAIL DATE	DELIVERY MODE
04/28/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/646,193	**Applicant(s)** BAIN, PETER	
	Examiner KIBROM K. GEBRESILASSIE	**Art Unit** 2128	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 March 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
    See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

/Hugh Jones/
Primary Examiner, Art Unit 2128

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant's argument relating to 101 rejection is not persuasive.

The "computer readable medium" embodied not only statutory mediums but also non-statutory mediums such as "carrier waves". As indicated in the final office action, the computer medium recited in claims is not limited to physical article or objects which constitute a manufacture within the meaning of 35 USC 101. Applicants needed to amend claims to only reflect physical specific storage mediums excluding non-statutory mediums such as "carrier waves". It is not disavowing the term "computer readable medium" as applicants indicated in their reply.

Applicant's argument relating to art rejection is not persuasive.

Applicants argued, "the passage is making clear that the obfuscation circuitry is automatically inserted in an electronic design using systems and methods, and that these "systems and methods are implemented as software programs". The passage does not state that an electronic design is implemented as or represents a software program".
In response, applicants are clearly indicated, inserting an obfuscation circuitry, which is a software program. Jakubowski et al clearly discloses an obfuscation circuitry (i.e. software programs) in an electronic design (i.e. digital goods) (See: Col. 3 lines 56-67, Col. 4 lines 1-4). Further, it is well known that IP-core takes in the form of a computer program in some HDL-such as Verilog, VHDL or SystemC that are a standard text based expressions of a software programs. Therefore, it is clear that an electronic design (i.e. IP core) not only expressed as a physical layout but also expressed as a standard text of software programs. Therefore, digital goods of the prior art could interpreted as an electronic design of the claimed invention.

Applicants argued that "nowhere is disclosed adding any type of actual circuitry to an electronic design". In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., adding an "actual circuitry" to an electronic design) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See In re Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).
Further, it could also raise a question when applicants recited "actual circuitry", is it possible to have an "actual circuitry" if the system and methods are implemented in a software program as applicants indicated in their response. Further, if applicant's invention deals with an "actual circuitry", then is it possible to create a simulation model as claimed?

applicants also argued that the prior art does not disclose" wherein said obfuscation circuitry prevents practical implementation of the electronic design on the target hardware device". In response, the prior art clearly discloses adding an obfuscation circuitry to produce a protected digital good to prevent or illegally copying or otherwise distributing the digital goods to others (See: Col. 4 lines 5-15).

Applicants are also indicated "applicant does not fully understand what "compilation" the office action is referring to. In response, claim 1 recites "receiving a non-obfuscated version of the electronic design "suitable for direct compilation" into a practical hardware implementation of the electronic design". As seen in the claim the recited limitation of "compilation" is just an intended use. There is not any "compiling" done. It is just referring to "suitable for" and therefore no patentable weight is given for this matter.